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EXAMINER

SALLIARD, SHANNON S

ART UNIT

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3628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/784,008 | Applicant(s) ADAMSON ET AL. | |
| | Examiner SHANNON S. SALIARD | Art Unit 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1 and 11. Claims 19-21 have been cancelled. Claims 22-29 are newly added. Thus, claims 1-18 and 22-29 remain pending and are presented for examination.

Response to Arguments

2. Applicant's amendments filed 10 November 2008, with respect to the rejection of claims 11-18 under 35 U.S.C. 112, First Paragraph, have been fully considered and are persuasive. Thus, the rejection of claims 11-18 under 35 U.S.C. 112, First Paragraph has been withdrawn.

3. Applicant's amendments, filed 10 November 2008, with respect to the rejections of claims 1-4 under 35 U.S.C. 101 have been fully considered and are not persuasive. While claims 1-4 identify the apparatus as a computing device and/or storage system, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson, 409 U.S. at 71-72.* As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance

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and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., *Flook*, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). *see Ex parte Langemyr*. Since the use of a computing system and a storage system are considered to be a nominal recitation of structure, and nominal recitations do not convert an otherwise non-statutory process into a process, claims 1-4 are directed to non-statutory subject matter. Thus, the rejections of claims 1-4 under 35 U.S.C. 101 has been upheld.

4. Applicant's arguments, with respect to claim the rejection of claim 1-18 under 35 U.S.C. 103 (a), have been considered but are moot in view of the new ground(s) of rejection.

5. In addition, Applicant argues, "Nor do the references teach, suggest or motivate that the member can enter into bilateral contracts with the potential destination event organizer for the services identified in the electronic form for the given destination event." However, Examiner disagrees. As discussed in the Office Action dated 10 July 2008, Wright does not explicitly disclose having the CVB electronically communicate with each of the at least two members of the CVB that the response to the RFP has been accepted; and communicating that the member can enter into direct bilateral contracts with the potential destination event organizer for the services identified in the

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electronic form for the given destination event. However, Wright discloses that the owner (potential destination event organizer) in conjunction with the project manager (CVB) accepts the response to the RFP for the given destination event [col 9, line 67- col 10, line 2]. The Examiner interprets accepting of a proposal by both parties as entering into a contract, since both parties agree to the terms of the proposal. Furthermore, a contract is considered to be bilateral by nature since it is a contract between two parties. Thus, based on the teachings of Wright et al and the common knowledge known in the art at the time of the invention, it would be obvious that if the owner accepts the proposal of the Provider, that the organizer and provider enter into a bilateral contract for the services identified in the proposal.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-4** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per **claims 1-4** are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*,

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409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). While claims 1-4 identify the apparatus as a computing device and/or storage system, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., *Flook*, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). *see Ex parte Langemyr*. Since the use of a computing system and a storage system are considered to be a nominal recitation of structure, and nominal recitations do not convert an

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otherwise non-statutory process into a process, claims 1-4 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 2, 9, 11, 12, 18, 22, 23, and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al [US 6,581,040] in view of Greene et al [US 2003/0004854].

As per **claims 1, 11, 12, 22, and 23**, Wright et al discloses a method of providing a computerized integrated sales system for destination events comprising: receiving a request for proposal (RFP) from a potential destination event organizer requesting information from a convention visitor bureau (CVB) organization on hosting a given destination event [col 8, lines 18-21; owner enters specs for project]; having the CVB organization compile related information about the RFP and electronically publish the RFP and related information on a member user interface hosted by an application service provider and accessible to a plurality of independent service providers that are members of the CVB organization [col 9, lines 32-45; col 10, lines 16-19]; having at least two of the members of the CVB organization periodically log into the member user

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interface hosted by a computing system maintained by an application service provider to review the RFP and related information and, in response, complete an electronic form on the member user interface for any services responsive to the RFP that the member is willing to make available [col 9, lines 54-60]; and automatically incorporating information from the electronic form into a projected service availability database stored in a storage system maintained by the application service provider [col 10, lines 9-25]; having the CVB organization review the projected service availability database for the RFP for the given destination event and prepare an aggregated response to the RFP that includes information about services from at least two members of the CVB that is then communicated to the potential destination event organizer [col 9, lines 56-64]. Wright et al does not explicitly disclose if the potential destination event organizer accepts the response to the RFP for the given destination event, having the CVB electronically communicate with each of the at least two members of the CVB that the response to the RFP has been accepted; and communicating that the member can enter into direct bilateral contracts with the potential destination event organizer for the services identified in the electronic form for the given destination event. However, Wright discloses that the owner (potential destination event organizer) in conjunction with the project manager (CVB) accepts the response to the RFP for the given destination event [col 9, line 67- col 10, line 2; The Examiner interprets accepting of a proposal by both parties as entering into a contract, since both parties agree to the terms of the proposal. Furthermore, a contract is considered to be bilateral by nature since it is a contract between two parties]. Thus, it would be obvious that if the

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organizer accepts the bid of the provider, that the organizer and service provider enter into a bilateral agreement for services. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Wright et al to include communicating that the member can enter into direct bilateral contracts with the potential destination event organizer for the services identified in the electronic form for the given destination event so that there is no variance in services rendered.

Wright et al does not disclose that the information in the database is accessible only by the CVB. However, Wright et al disclose that the complete database is not available to every user [col 10, lines 10-12]. Hence, it is well within the knowledge of one of ordinary skill in the art at the time of the invention to manage database rights so that only one organization would have rights to specific database (e.g. projected service availability database). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include providing the CVB with the only rights to access the projected service availability database for security purposes.

Wright et al does not disclose wherein the data related to the services contained in the completed form is confidential to the CVB organization and the member of the CVB organization who is willing to make said services available. However, Green et al discloses a completed proposal is confidential to CVB organization and the member who is willing to make services available [Abstract; 00036]. It would have been obvious to one of ordinary skill in the art to include in the RFP system of Wright et al the ability to have confidentiality in the RFP process as taught by Green et al since the claimed

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invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 2**, Wright et al further discloses wherein updates to information in an RFP provided by the potential destination event organizer is automatically made available by the CVB to members via the member user interface [col 9, lines 29-37].

As per **claims 9, 18, and 29**, Wright et al further discloses wherein the application service provider also hosts a customer webpage interface and the potential destination event organizer submits the RFP for a given destination event via the customer webpage interface [col 11, lines 11-20].

10. **Claims 3, 4, 13, 14, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al [US 6,581,040] in view of Greene et al [US 2003/0004854] and Creedle et al [US 2008/0133307].

As per **claims 3, 13, and 24**, Wright et al does not explicitly disclose wherein once the electronic form is submitted by a member, any changes to the electronic form made by a member are made to the projected service availability database only when approved by the CVB. However, Creedle et al discloses any changes to the project proposal are approved by schedule reviewer/ general contractor (CVB) [0045; 0055]. It would have been obvious to one of ordinary skill in the art to include in the event organizing system of Wright et al the ability to allow the CVB to approve changes made

by a member taught by Creedle et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claims 4, 14, and 25**, Wright et al does not disclose wherein the application service provider automatically maintains an audit trail of all information submitted by each member via the electronic form to the projected service availability database and all changes approved by the CVB. However, Creedle et al Creedle et al discloses any changes to the project proposal are approved by schedule reviewer/general contractor (CVB) [0045; 0055]. Creedle et al further discloses that the project auditor can view audit trails for the project [0045]. It would have been obvious to one of ordinary skill in the art to include in the event organizing system of Wright et al the ability to maintain an audit trail of changes as taught by Creedle et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. **Claims 5-8, 15-17, and 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al [US 6,581,040] in view of Greene et al [US 2003/0004854] and Tromczynski et al [US 2006/0010023].

As per **claim 5**, Wright et al does not disclose wherein the RFP includes a date

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by which the response is due and the application service provider automatically sends email reminders to members if the members have not submitted electronic form for the RFP prior to the date by which the response is due. However, Tromczynski et al discloses sending a reminder to service providers as the due date for RFPs approaches [0048]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include the method disclosed by Tromczynski et al so that all providers are provided an opportunity to reply.

As per **claims 6, 15, and 26**, Wright et al does not disclose wherein the members of the CVB organization include at least two hotel members and the electronic form for the hotel members includes availability and prices for blocks of hotel rooms in response to the RFP, and wherein the projected service availability database includes a projected occupancy room flow for the destination that the CVB organization utilizes in preparing the response to the RFP. However, Tromczynski et al discloses that CVB organization includes a hotel and the hotel provides availability and prices for rooms. Tromczynski et al further discloses that the number of available guest rooms is considered when accepting selecting a provider [0038]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include the method disclosed by Tromczynski et al to ensure proper accommodations.

As per **claims 7, 16, and 27**, Wright et al does not disclose wherein the application service provider includes a software module that automatically analyzes the projected occupancy room flow and generates a hotel availability portion of the

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response to the RFP. However, Tromczynski et al discloses providing summaries of availability for services for a required date [0038]. Further, it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result, see *In re Venner*, 120 USPQ 192 (CCPA 1958). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include the method disclosed by Tromczynski et al so that organizer makes a well informed decision.

As per **claims 8, 17, and 28**, Wright et al does not disclose wherein the application service provider hosts a software module that selectively integrates portions of the projected service availability database in order to display on the member user interface non-confidential summaries of the future availability of selected services for the destination by date. However, Tromczynski et al discloses providing non-confidential (i.e., published on website) summaries of availability for services for a required date wherein the availability is stored in a database [0038]. Further, it is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result, see *In re Venner*, 120 USPQ 192 (CCPA 1958). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include the method disclosed by Tromczynski et al so that organizer makes a well informed decision.

12. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright et al [US 6,581,040] in view of Greene et al [US 2003/0004854] and Official Notice.

As per **claim 10**, Wright et al does not disclose wherein software modules that support the member user interface and the projected services availability database are updated and maintained by the application service provider and not by the CVB organization. However, the Examiner takes Official Notice that it is old and well known in the computer industry to have an application service provider update and maintain software. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Wright et al to include wherein software modules that support the member user interface and the projected services availability database are updated and maintained by the application service provider and not by the CVB organization to streamline operations.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Shannon S Saliard
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